



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,268	11/17/2003	Serengulam V. Govindan	018733-1317	1475

26633 7590 11/24/2004

HELLER EHRMAN WHITE & MCAULIFFE LLP
1666 K STREET,NW
SUITE 300
WASHINGTON, DC 20006

EXAMINER

CELSA, BENNETT M

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2nd substitute restriction/ELECTION Office Action Summary	Application No.	Applicant(s)	
	10/713,268	GOVINDAN, SERENGULAM V.	
	Examiner	Art Unit	
	Bennett Celsa	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 and 23-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 11-20 and 23-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

SECOND SUBSTITUTE *Election/Restriction*

Status of the Claims

Claims 11-20 and 23-32 are currently pending.

SECOND SUBSTITUTE *Election/Restriction*

In light of the Preliminary Amendment which cancelled claims 1-10 and 21-22, amended claim 11 and added new claims 23-32, the prior Restriction/Election And Substitute Restriction /Election is hereby withdrawn; and the following substitute Election/Restriction requirement is now in effect.

1. Restriction to one of the following inventions is required under

35 U.S.C. 121:

- I. Claims 11-20 and 23-32 (all in part) drawn to a method of making a glycopeptide to which the carbohydrate is attached to D-Lys, classified in class 530, subclass 345.
- II. Claims 23-32 (all in part), drawn to a method of making a glycopeptide to which the carbohydrate is attached to D-Arg, classified in class 530, subclass 345.
- III. Claims 23-32 (all in part), drawn to a method of making a glycopeptide to which the carbohydrate is attached to D-Orn, classified in class 530, subclass 345.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-III are drawn to independent and/or patentably distinct methods of making glycopeptide compounds since the methods differ in method steps and reactants (e.g. sugar conjugation to different amino acids) and due to the making of independent and/or patentably distinct glycopeptide compounds due to differences in chemical structure, differences in chemical/physical/biological properties, which are capable of different manufacture and/or use and which are administratively burdensome to examine together due an Examination (e.g. different issues under 35 USC 112/102/103) and Search (e.g. sequence/bibliographic/ structure) burden which is diverse and separately burdensome.

3. Because these inventions are distinct for the reasons given above and:

- I. have acquired a separate status in the art;
 - II. require separate and burdensome manual and computer searches: and
 - III. because of their recognized divergent subject matter;
- restriction for examination purposes as indicated is proper.

Upon the election of the Groups I-III above the following election of species is required:

Election/Restriction (all groups)

This application contain claims directed to the methods of synthesizing independent and/or patentably distinct species of carbohydrate-appended peptides including linker.

The synthesized compounds which are within the scope of the presently claimed invention include compounds which: differ in structure; lack a common core which elicits

Art Unit: 1639

a common activity; possess different physicochemical properties; are capable of separate manufacture and/or use; and necessitate separate and unduly burdensome manual and/or computer structure, bibliographic, sequence and structure searches.

Accordingly, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species **(e.g. a single defined compound) ALONG WITH A CORRESPONDING STRUCTURE** in accordance with the above election of species above, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable

Applicant is advised that a reply to this requirement **must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable** thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

Art Unit: 1639

the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

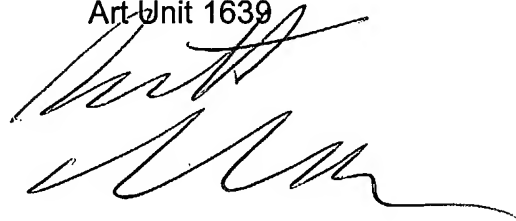
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Celsa whose telephone number is 571-272-0807. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-273-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bennett Celsa
Primary Examiner
Art Unit 1639



BC
November 23, 2004